

**REMARKS:**

Claims 1-41 remain in the application for consideration of the Examiner.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the following remarks.

**REJECTIONS UNDER 35 U.S.C. § 102:**

Claims 1-18 and 21-40 stand rejected under 35 U.S.C. § 102(a) over International Application Publication No. WO 00/17795 to Kennedy, et al. ("Kennedy").

However, Kennedy fails to disclose all of the limitations of claims 1-18 and 21-40, as discussed below. Therefore, Kennedy cannot anticipate claims 1-18 and 21-40.

A claim is anticipated by a prior art reference only if the reference discloses or inherently describes every detail of the claim. According to the MPEP, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."<sup>1</sup> Also according to the MPEP, "[T]he identical invention must be shown in as *complete detail* as is contained in the ... claim."<sup>2</sup>

**Claims 1-21**

Claim 1 recites:

A fulfillment management system, comprising:  
a local database operable to store consolidated product availability information associated with at least one product, the consolidated product availability information consolidated from a plurality of available-to-promise (ATP) servers, the local database separate and distinct from the plurality of ATP servers; and

...

the consolidated product availability information stored in the local

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<sup>1</sup> MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)(Emphasis added).

<sup>2</sup> MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Emphasis added).

database enabling the component quotation to be generated and communicated without retrieving product availability information from the plurality of ATP servers in response to receiving the at least one component ATP request.

Thus, claim 1 recites a fulfillment management system that (1) comprises a local database for storing consolidated product availability information, and (2) the consolidated availability information stored in the database allows a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request. Claims 2-21 depend from claim 1 and therefore include the same limitations at least by reference.

As previously pointed out in response to the Office Action dated 19 April 2005, Kennedy fails to disclose or suggest at least the following limitations as recited in claim 1:

- (a) a local database for storing consolidated product availability information; and
- (b) the consolidated availability information stored in the database allows a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request.

Each of these points is discussed further below.

Point (a)

The previous Office Action conceded that "Kennedy fails to explicitly disclose a local database storing consolidated product availability information from a plurality of available to promise server (sic)."<sup>3</sup>

Nevertheless, the present Office Action now alleges that Kennedy does disclose the claimed database:

Kennedy discloses local database (via local fulfillment manager 22) operable to store consolidated product availability information (page 10, lines 31-32).<sup>4</sup>

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<sup>3</sup> Office Action, p. 4 (15 March 2005).

<sup>4</sup> Office Action, p. 7 (24 August 2005).

However, Applicants have reviewed the cited portion of Kennedy and must respectfully disagree with this allegation. The cited portion of Kennedy states:

Fulfillment server 16 uses business constraints described above, which it may have previously stored, may receive within ATP requests from clients 12, or both, to source request line-items to particular LFMs 22 or to filter out any component quotation and component promise responses from LFMs 22 that do not satisfy these constraints.<sup>5</sup>

It is respectfully submitted that the cited portion of Kennedy does not disclose stored consolidated product availability information as claimed. Instead, the above only discloses that business constraints can be stored at the fulfillment server.

As pointed out above, “[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”<sup>6</sup> Here, “each and every element” includes the claimed stored consolidated product availability information. As also pointed out above, “[T]he identical invention must be shown in as *complete detail* as is contained in the ... claim.”<sup>7</sup> Here, Kennedy does not show the claimed invention in “as complete detail” as is contained in claim 1, particularly since Kennedy is silent with respect to the claimed stored consolidated product availability information. Therefore, for at least this reason, Kennedy cannot anticipate claim 1, or claims depending from claim 1.

Nevertheless, if the present rejection is maintained, it is respectfully requested that a clear explanation be provided as to how Kennedy is considered to disclose or suggest this limitation.

Point (b)

In the present Office Action, under a section heading “Response to Arguments,” the following is stated with respect to point (b):

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<sup>5</sup> Kennedy, p. 10, l. 30 – p. 11, l. 1.

<sup>6</sup> MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)(Emphasis added).

<sup>7</sup> MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Emphasis added).

Kennedy further discloses enabling the component quotation to be generated and communicated without retrieving product availability information from the plurality of ATP servers in response to retrieving one component ATP request (see page 24, lines 5-11).<sup>8</sup>

However, Applicants respectfully submit that since the above statement is substantially identical to the original statement of the rejection, it provides no clarification as to how Kennedy is considered to disclose or suggest the claimed elements, including consolidated availability information stored in the database that allows a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request. The cited portion of Kennedy states:

There may be little functionality for controlling the output structure of the resulting quotation response from the standpoint of shipment timing and lot sizing. In this situation, LFM 22 may submit the quotation request as a planning transaction and evaluate the quotation response according to the business constraints encapsulated in component ATP request 32. If the response from ATP server 14 does not meet these requirements, LFM 22 identifies this and sends a failure notification to fulfillment server 16.<sup>9</sup>

Applicants have reviewed the cited portion of Kennedy, but have found no disclosure or teaching as alleged in the Office Action that is adequate for anticipating this limitation of claim 1. In fact, the cited portion explicitly discusses “submit[ting] the quotation request” and conditioning a notification based on a “response from ATP server.” Thus, the cited portion actually teaches away from allowing a component quotation to be generated without retrieving product availability information from ATP servers as claimed.

Thus, Applicants maintain that Kennedy fails to teach or suggest consolidated availability information stored in a local database that allows a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request. Therefore, for at least this reason, Kennedy cannot anticipate claim 1, or claims depending from claim 1.

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<sup>8</sup> Office Action, p. 7 (24 August 2005)..

<sup>9</sup> Kennedy, p. 24, l. 5 – 11.

Nevertheless, If the present rejection is maintained, it is respectfully requested that a clear explanation be provided as to how Kennedy is considered to disclose or suggest this limitation.

### **Claims 22-41**

With respect to independent claims 22, 39, 40, and 41, each of these claims includes limitations similar to those discussed above in connection with claim 37. Thus, the arguments presented above in connection with claim 1 apply equally to claims 22, 39, 40, and 41, as well as their dependent claims.

For the reasons set forth herein, the Applicants submit that claims 1-18 and 21-40 are not anticipated by Kennedy. The Applicant further submits that claims 1-18 and 21-40 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 1-18 and 21-40 be reconsidered and that claims 1-18 and 21-40 be allowed.

### **LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. **Prior Knowledge**: The invention was publicly known in the United States before the patentee invented it.
2. **Prior Use**: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. **Prior Publication**: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.



The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**REJECTIONS UNDER 35 U.S.C. § 103:**

Claims 19, 20, and 41 stand rejected under 35 U.S.C. § 103(a) over Kennedy.

Claims 19 and 20 depend from independent claim 1, and claim 41 is an independent claim addressed above. As pointed out above, Kennedy fails to disclose or suggest all of the limitations of claims 1 and 41. The Office Action cites no references in combination with Kennedy, so there is no cited reference that cures the deficiencies of Kennedy noted above. Further, the Official Notice taken by the Examiner that HTTP is known in the art also fails to cure the deficiencies of Kennedy noted above. Thus, Kennedy fails to render obvious claims 1 and 41, as well as claims 19 and 20, which depend from claim 1.

For the reasons set forth herein, the Applicant submits that claims 19, 20, and 41 are not rendered obvious by Kennedy. The Applicant further submits that claims 19, 20, and 41 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 19, 20, and 41 be reconsidered and that claims 19, 20, and 41 be allowed.

**LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

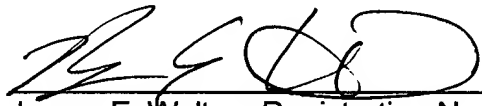
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

23 Nov 2005  
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